

**Notice of Allowability**

Application No.

10/720,790

Examiner

Andrew B. Freistein

Applicant(s)

BANNER ET AL.

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to Remarks filed 5/25/2006.
2. ☒ The allowed claim(s) is/are 1-63 and 65. (now 1-64)
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some\* c) ☐ None of the:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),  
Paper No./Mail Date 5/4/06
4. ☐ Examiner's Comment Regarding Requirement for Deposit  
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413),  
Paper No./Mail Date 20060602.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_.

### **DETAILED ACTION**

Claims 1-67 are currently pending in the instant application.

#### ***Information Disclosure Statement***

Applicant's information disclosure statement (IDS), filed on 5/4/2006, has been considered. Please refer to Applicant's copies of the 1449 submitted herewith.

#### ***Restriction Requirement***

Upon further consideration, Group I is deemed allowable. Group II is rejoined and the restriction requirement is withdrawn.

#### ***Examiner's Amendment***

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given during a telephone interview with Attorney David E. Wildman on June 2, 2006.

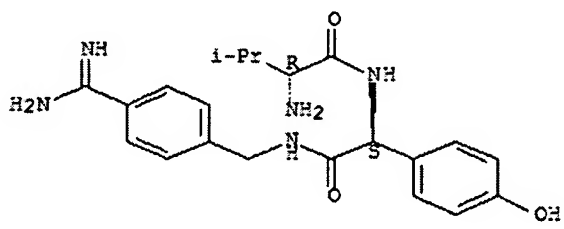
This application has been amended as follows:

1. In claim 43, on page 209, on line 8 of the page, delete the species, "(RS)-(2,6-Difluoro-4-trifluoromethanesulfonyloxy-phenyl)-ethoxy-acetic acid ethyl ester,".
2. In claim 43, on page 209, on lines 9-10 of the page, delete the species, "(RS)-4-(Ethoxy-ethoxycarbonyl-methyl)-3,5-difluoro-benzoic acid 2-trimethylsilanyl-ethyl ester,".
3. Cancel claims 64, 66 and 67.

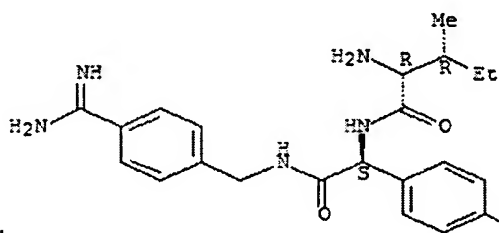
### ***Reasons for Allowance***

The instant invention is drawn to compounds of formula (I), a pharmaceutical composition comprising a compound of formula (I), and a process for the manufacture of compounds of formula (I).

The closest relevant art is Shiraishi et al., US Pat. No. 7,001,887, which

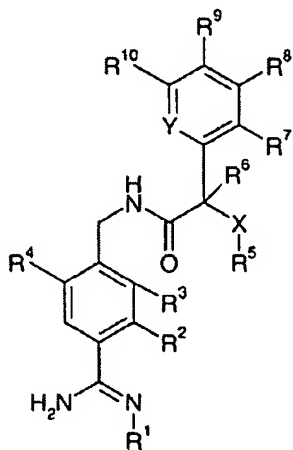


discloses the compounds:



and (see Shiraishi et al, STN International, HCAPLUS Database, Columbus, OH, Accession No. 2002:615652, Reg. No. 446846-14-6 and 446846-17-9 (2006)).

The instant invention is patentable over Shiraishi et al., because formula (I), of



the instant invention,

, has the variables X-R<sup>5</sup>, wherein X is NR<sup>12</sup>;

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R<sup>12</sup> is H, lower-alkyl, or lower-alkyl-carbonyl; and R<sup>5</sup> is lower alkyl, cycloalkyl or H.

Shiraishi et al. disclose compounds where this portion of the compound contains an amino group.

***Telephone Inquiry***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew B. Freistein whose telephone number is (571) 272-8515. The examiner can normally be reached Monday-Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph M<sup>c</sup>Kane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

Andrew B. Freistein  
Patent Examiner, AU 1626

KAMAL A. SAEED, PH.D.  
PRIMARY EXAMINER

  
for Joseph K. M<sup>c</sup>Kane  
Supervisory Patent Examiner, AU 1626  
Date: June 6, 2006